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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

LY, CHEYNE D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1631

DATE MAILED: 04/22/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,056

Applicant(s)

PERSON, CHRISTOPHE

Examiner

Cheyne D Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-60 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The art unit designated for this application has changed. Applicants(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-25, drawn to a database of unique nucleotide sequences, classified in classes 702 and 707, subclasses 20 and 1, respectively. If this Group is elected, then the below summarized 2 species sets (A and B), election of a species from each set is required.
 - II. Claims 26-56, drawn to a method for generating a database of sequences that are greater than or equal to about 100 nucleotides in length, classified in class 702, subclass 20. If this Group is elected, then the below summarized 5 species sets (A-E), election of a species from each set is required.
 - III. Claim 57, drawn to a process of Figure 1A, classified in class 702, subclass 20. If this Group is elected, then the below summarized 5 species sets (A-E), election of a species from each set is required.
 - IV. Claim 58, drawn to a process of Figure 1B, classified in class 702, subclass 20. If this Group is elected, then the below summarized 5 species sets (A-E), election of a species from each set is required.
 - V. Claim 59, drawn to a process of Figure 2, classified in class 702, subclass 20. If this Group is elected, then the below summarized 5 species sets (A-E), election of a species from each set is required.

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- VI. Claim 60, drawn to a method for identifying unique nucleotide sequences, classified in class 702, subclass 20. If this Group is elected, then the below summarized 5 species sets (A-E), election of a species from each set is required.

SPECIE ELECTION REQUIREMENT:

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

FOR ALL GROUPS:

Sources of nucleic acid sequence (A):

3. Species of sources of nucleic acid sequence species are cited in claims 6-15, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select an unspecified source of nucleic acid sequence species or a type of source of nucleic acid sequence species from those listed in claims 6-15.

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-5, 16-29, and 40-60 are generic to the above species in all Groups.

Medium Species (B):

5. Species of encoded medium are cited in claims 16-19, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select an unspecified type of medium or a type of medium from those listed in claim 16-19.

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6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-15, 21-39, and 45-60 are generic to the above species in all Groups.

FOR GROUPS II-VI:

Public domain database species (C):

7. Species of public domain database species are cited in claims 46-49, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select an unspecified type of public domain database species or a type of public domain database species from those listed in claims 46-49.

8. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 26-45 and 50-60 are generic to the above species in all Groups.

Database search algorithm species (D):

9. Species of database search algorithm are cited in claims 51-53, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select an unspecified type of database search algorithm or a type of database search algorithm from those listed in claims database search algorithm.

10. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally

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held to be allowable. Currently, claims 1-50 and 54-60 are generic to the above species in all Groups.

Scoring matrix program species (E):

11. Species of scoring matrix program are cited in claims 55 and 56, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select an unspecified type of scoring matrix program or a type of scoring matrix program from those listed in claims 55 and 56.

12. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-54 and 57-60 are generic to the above species in all Groups.

13. Applicant is advised that a reply to this requirement must include an identification of a specie from list of specie sets cited above that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

14. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

15. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

16. Inventions of Groups I and [II-VI] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this instant application, the database of Group I maybe practiced in the distinct practices as cited in Groups II-VI. Alternatively, the methods of Groups II-VI maybe practiced with another unspecified database containing unique sequences that are distinct from sequences contained in the database of Group I. The database and methods are distinct as requiring distinct and different functions and results thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were search together.

17. The inventions of Groups II-VI are distinct inventions because they are directed to different methods or processes regarding the critical limitations therein. For Group II, the critical feature is the method for generating a database. For Group III, the critical feature is the process of Figure 1A. For Group IV, the critical feature the process of Figure 1B. For Group V, the critical feature is the process of Figure 2. For Group VI, the critical feature is the method for

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identifying unique nucleotide sequences. The completely distinct critical features of each Group of the inventions support the undue search burden if they were examined together.

18. It is acknowledged that the commonality of the inventions (Group I-VI) is the nucleic acid data contained in the database or required by each method or process. However, these inventions are distinct due the different usages of the nucleic acid sequences. For Group I, the database requires the nucleic acid sequences as the data source. For Groups II-VI, the nucleic acid sequences are processed differently according the active steps of each respective method to achieve their intended utilities. Theses methods have been most commonly, albeit not always, separately characterized and published in the Biochemical literature, thus significantly adding to the search burden if examined together as compared to being search separately.

19. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

20. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

21. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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22. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

25. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly
4/21/03


ARDIN H. MARSCHEL
PRIMARY EXAMINER